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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/699,876

11/04/2003

Satoshi Nishikawa

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EXAMINER

WILLS, LAWRENCE E

ART UNIT

PAPER NUMBER

2609

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/699,876

Applicant(s)

NISHIKAWA, SATOSHI

Examiner

Lawrence E. Wills

Art Unit

2609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/14/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 21 and 26** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the "printing control program" is functional descriptive material, since the program is not imparting functionality to a control unit or on a computer readable medium. The claim rejection can be overcome by changing "printing control program" to "image forming program stored on a computer readable medium" or "image forming program stored on a memory unit and retrieved to be executed by a control unit".

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**3. Claims 1-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ferlitsch et al. (US 2002/0113989)** in view of **Petz (WO 200282362 A2 -- US Patent Application Publication No. 2004/0187087 is used in lieu of English translation).**

With regard to claims 1, 11, and 21, Ferlitsch teaches an information processing apparatus comprising storage 22 (spooler) which saves printing data 20 of each original page in an intermediate format together with printing setting data;; a printing controller 26 (print task modification commands) which causes a user to change a printing setting and issue a printing instruction; and a printing data reading unit 24 (cluster-enabled print processor) which reads out the printing setting data from said storage in accordance with the printing instruction, changes a setting of the read printing setting data in accordance with a setting in the printer that is changed by said printing controller, and generates by using the generation function the printing data containing an instruction of changing the color mode on the basis of the printing setting data, (See Figure 3, in addition, [0035]-[0037] or Figure 2, in addition, [0033]). Ferlitsch does not teach the setting as a color mode of print data.

Petz teaches the color mode setting of the printing setting, (See claim 8). At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to change the color setting of the modifiable print data. The motivation for doing so would have been to increase the versatility of the print processor. Therefore, it

would have been obvious to combine Petz with Ferlitsch to obtain the invention as specified in claims 1, 11, and 21.

**With regard to claims 2, 12, and 22,** Petz teaches the printing setting changed by said printing controller includes the color mode setting of each original page in the printer (claim 8), printing data reading unit changes the color mode setting of the read printing setting data for each printing medium including the original page whose printing setting has been changed, (See [0039]).

**With regard to claims 3, 13, and 23,** Petz teaches the print setting changed by said printing controller includes the color mode setting (overlay information) of each chapter formed by a plurality of original pages in the printer, and said printing data reading unit changes the color mode setting of the read printing setting data for a set of printing media corresponding to the chapter whose printing setting has been changed, (See [0051]).

**With regard to claims 4, 14, and 24,** Ferlitsch teaches printing data reading unit determines whether the printer copes with a change of the color mode before the printing data containing the instruction of changing the color mode is generated by using the generation function, when the printer copes with the change, generates, by using the generation function, printing data containing the instruction of changing the color mode, and when the printer does not cope with the change, generates, by using the generation function, printing data containing no instruction of changing the color mode, (See [0067]).

**With regard to claims 5, 15, and 25**, Petz teaches the printing data reading unit determines whether the printing setting changed by said printing controller includes the color mode setting of each original page in the printer, when the printing setting includes the color mode setting of each original page, changes the color mode setting of the read printing setting data for each printing medium including the original page whose printing setting has been changed, when the printing setting does not include the color mode setting of each original page, determines whether the printing setting includes the color mode setting of each chapter formed by a plurality of original pages in the printer, when the printing setting includes the color mode setting of each chapter, changes the color mode setting of the read printing setting data for a set of printing media corresponding to the chapter whose printing setting has been changed, and when the printing setting does not include the color mode setting of each chapter, changes the color mode setting of the whole printing data in the printer, (See [0051] and [0053]).

**With regard to claims 6, 16, and 26**, Ferlitsch teaches an information processing apparatus which generates printing data to be transmitted to a printer, comprising: a save unit 22 which saves document data to be printed together with printing setting data; a printing setting unit 26 which sets in printing setting data for a predetermined unit of document data; and printing data generation 24 means for generating the printing data by issuing a setting designation instruction in order to change the mode for the predetermined unit on the basis of the printing setting data.

(See Figure 3, in addition, [0035]-[0037] or Figure 2, in addition, [0033]). Ferlitsch does not teach the setting as a color mode of print data.

Petz teaches the color mode setting of the printing setting, (See claim 8). At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to change the color setting of the modifiable print data. The motivation for doing so would have been to increase the versatility of the print processor. Therefore, it would have been obvious to combine Petz with Ferlitsch to obtain the invention as specified in claims 6, 16, and 26.

**With regard to claims 7, 17, and 27,** Ferlitsch teaches the save unit 22 converts data input from an application, and stores the converted data as the document data of an intermediate format in a document file, (See [0035]).

**With regard to claims 8, 18, and 28,** Petz teaches the save unit manages the document data by a tree structure having a plurality of chapters defined by dividing the document data into a plurality of original pages, (See [0051] and [0053]).

**With regard to claims 9, 19, and 29,** Petz teaches the printing setting unit can set designation of the color mode for each original page, each chapter, and the whole document data, (See [0051] and [0053]).

**With regard to claims 10, 20, 30,** Petz teaches the printing setting unit can designate whether the color mode for a chapter of the document data is set to the color mode of the whole document data or separately set, (See [0051] and [0053]).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Petz (US 2004/0187081) used as translation for WO 200282362 A2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence E. Wills whose telephone number is 571-270-3145. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on 571-272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2609

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEW  
August 9, 2007

A handwritten signature in black ink, appearing to read 'Alexander Eisen', with a stylized, flowing script.

ALEXANDER EISEN  
SUPERVISORY PATENT EXAMINER